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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/719,581 | 11/21/2003 | Kurt K. Carbonero | 0889.3029.002 | 3250 |

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Troy, MI 48099-4390

EXAMINER

WONG, STEVEN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3711

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,581

Applicant(s)

CARBONERO, KURT K.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (3,858,876). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2-6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,858,876) in view of Poegel, Jr. (D485,316). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.
5. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,858,876) in view of Page et al. (6,722,889). Note the basis for the rejections set forth in the Office Action mailed January 10, 2005.

Response to Arguments

6. Applicant's arguments filed February 11, 2005 have been fully considered but are not deemed to be persuasive. The applicant argues that the Williams patent when taken, as a whole, teaches the placement of the user's palm on the ball. The applicant states that Figures 5 and 9 of Williams teach the placement of the user's palm on the ball and it would be highly unlikely for Williams to teach contrary instructions for Figure 6 where a user would not place his palm on the ball. However, this argument is not persuasive as the indicia of Williams is still seen as being

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inherently capable of teaching that a user's hand should not touch the ball. Regarding the assertion that it would be highly unlikely for Williams to provide contradicting instructions, this argument is not persuasive as it is not based on any factual evidence. It is also noted that references often provide multiple embodiments including teachings that are somewhat contradictory.

Regarding the applicant's statement that Williams does not provide indicia indicating that a person's palm should not touch the ball, attention is first directed to Figure 5 of Williams showing a full palm of the user. Attention is next directed to Figure 6 providing a first image of a user's hand including the fingers and a portion of the palm. The indicia for the palm is abbreviated or cropped so that only a portion of the palm is depicted. This cropping corresponds to the instantly claimed first indicia as it is indicia that is inherently capable of acting as an indication that the person's palm should not touch the ball.

Regarding the applicant's argument that Figure 6 of Williams shows that at least part of the palm touches the ball, this is the applicant's own interpretation of the Figure, not based in fact. Nowhere in the specification of Williams does he state that the palm is to touch the ball. Williams addresses the alignment and placement of the hand of the user on the ball (column 2, lines 26-46), however he never states that the palm of the user is to contact the ball. While Williams provides an outline or a partial outline of the palm of the hand, nowhere is it stated that the user's hand is to contact the ball nor can it necessarily be inferred.

Regarding the missing case citation, the applicant is correct in assuming that it was intended to be *In re Gulack* 217 USPQ 401. The *Gulack* decision is very clear in stating that indicia is not normally accorded patentable weight unless applicant can show a new and

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unobvious relationship between the indicia and substrate. The applicant argues that the user, grasping the ball in the instantly taught method, will learn the proper way to control and pass the ball. However, this is not persuasive as first, the indicia is not seen as defining a relationship between the actual ball (the substrate) and the indicia itself. For example, while the indicia is used to indicate the placement of the user's hands, there is no specific requirement for the exact placement of the indicia on the ball for directing the user's hands nor for the ball to be of a specific size as required by the indicia. Indeed, the indicia of applicant's ball may be placed anywhere on the ball's surface simply as instructions for directing the user's placement of his hands on the ball. Further, the indicia may be used on any size sport ball and does not require a particular relationship between the size of the substrate and the meaning of the indicia. While these examples are not exhaustive of the new and unobvious relationships that would be required in order to give the indicia patentable weight they are examples of the threshold that the instant invention must meet in order to accord it patentable weight. Applicant's argument for the new and unobvious relationship is solely that the indicia allows a user to control and pass the ball in the proper way by directing a user's hand placement. This argument falls far short of the threshold that is required because the prior art (as evidenced Williams, Poegel, Jr. and Page et al) is replete with teachings of sport balls having indicia for directing a user's hand placement.

Regarding the rejection under 35 U.S.C. 103 and applicant's arguments directed to the *In re Gulack* case, attention is directed to the above paragraph discussing the *Gulack* decision and its relevance to the instant application. Again, the applicant's argument that the indicia of the instant invention permits better control and release of the ball falls far short of the threshold for a showing of a new and unexpected result obtained by the relationship between the printed matter

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and the substrate. Therefore, the indicia of Williams anticipates the claimed indicia of the instant invention because Williams provides a first image of a release hand and a cropped portion (as shown in Figure 6 and explained above) that is inherently capable of indicating that the person's palm should not touch the ball. The recitation of the meaning of the indicia relates to the intended use of the ball and the information conveyed by the printed matter and this recitation does not carry patentable weight for the reasons cited above. Therefore, because Williams provides indicia that is inherently capable of indicating that a person's palm should not touch the ball, the claim is anticipated.

Regarding the applicant's argument on claims 10 and 12, again the differences between the instant invention and the prior art reside solely in the meaning and information conveyed by the printed matter and those differences are not considered patentable differences. The applicant still has not demonstrated a new and unobvious relationship between the indicia and the substrate.

Attention is again directed to *In re Reeves* 20 CCPA 767, 62 F. 2d 199; *In re Russell* 18 CCPA 1184, 48 F.2d 668; *In re Sterling* 21 CCPA 1134, 70 F. 2d 910. Reeves states "that invention cannot rest alone in novel printing arrangement". Russell states "The mere arrangement of printed matter on a sheet or sheets of paper, in book form or otherwise, does not constitute 'any new and useful art, machine, manufacture, or composition of matter,' or 'any new and useful improvements thereof although it may reside in some physical structures of printed matter.'" Sterling states "we have held in a number of cases that the mere arrangement of printed matter on a sheet or sheets of paper does not constitute patentable subject-matter." Sterling also adds "patentable novelty cannot be predicated upon printing alone, but must reside in physical

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structure.” The applicant’s indicia relies on its arrangement and meaning conveyed, however, it does not reside in the physical structure of the ball.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

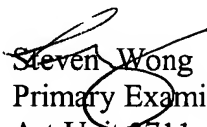
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
May 9, 2005